GAU 1646

Dkt. 59896/JPW/ADM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	Kenneth A. Jones et al.	
U.S. Serial No.	:	09/471,572	Group Art Unit: 1646
Filed	:	December 23, 1999	Examiner: J.F. Murphy
For	:	CHIMERIC G PROTEINS AND USES THEREOF	

1185 Ave of the Americas
New York, New York 10036
April 25, 2001

Duplicate Paper

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

COMMUNICATION IN RESPONSE TO MARCH 29, 2001 OFFICE ACTION

This Communication is submitted in response to the Office Action issued March 29, 2001 by the U.S. Patent and Trademark Office in connection with the above-identified application. A response to the March 29, 2001 Office Action is due April 29, 2001. Accordingly, this Communication is being timely filed.

Restriction Requirement Under 35 U.S.C. §121

In the March 29, 2001 Office Action, the Examiner to whom the subject application is assigned required restriction under 35 U.S.C. §121 to one of the following inventions:

I. Claims 1-22, drawn to a nucleic acid encoding a chimeric G protein with an amino acid sequence set forth in SEQ ID NO: 1, classified in class 536, subclass 23.5;

II. Claims 1-22, drawn to a nucleic acid encoding a chimeric G protein with an amino acid sequence set forth in SEQ ID NO: 2, classified in class 536, subclass 23.5;

III. Claims 1-22, drawn to a nucleic acid encoding a chimeric G protein with an amino acid sequence set forth in SEQ ID NO: 3,

classified in class 536, subclass 23.5;

IV. Claims 1-22, drawn to a nucleic acid encoding a chimeric G protein with an amino acid sequence set forth in SEQ ID NO: 4, classified in class 536, subclass 23.5;

V. Claims 1-22, drawn to a nucleic acid encoding a chimeric G protein with an amino acid sequence set forth in SEQ ID NO: 5, classified in class 536, subclass 23.5;

VI. Claims 1-22, drawn to a nucleic acid encoding a chimeric G protein with an amino acid sequence set forth in SEQ ID NO: 41, classified in class 536, subclass 23.5;

VII. Claim 77, drawn to a process for determining whether a chemical compound is a mammalian G protein-coupled receptor antagonist, classified in class 435, subclass 7.2; and

VIII. Claim 141, drawn to a process of screening clones for expression of a G-protein coupled receptor, classified in class 435, subclass 6.

The Examiner alleged that the inventions are distinct, each from the other because of the following reasons:

Inventions I-VI are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function, and each has an independent utility, that is distinct for each invention which cannot be exchanged;

Inventions II and III are independent and distinct, each from the other, because the methods are practiced with materially different starting materials, have materially different process steps, and are for materially different purposes;

Inventions (I-VI) and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP §806.05(h)). In the instant case the nucleic acid of invention I can be used for the production of protein; and

Inventions (I-VI) and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §806.04, MPEP §808.01). In the instant case the different inventions are not disclosed as capable of use together.

The Examiner concluded that because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and separate classification, restriction for examination purposes as indicated is proper.

The Examiner advised applicants that for the reply to this requirement to be complete, it must include an election of invention to be examined even though the requirement be traversed (37 C.F.R. §1.143).

The Examiner stated that applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. §1.48(b) if one or more of the currently named inventors are no longer an inventor of at least one claim remaining in the application. The Examiner further stated that any amendment of

inventorship must be accompanied by a petition under 37 C.F.R. §1.48(b) and by the fee required under 37 C.F.R. §1.17(i).

In response to this restriction requirement, applicants hereby elect, with traverse, to prosecute the invention of Examiner's Group I, i.e. Claims 1-22, drawn to a nucleic acid encoding a chimeric G protein with an amino acid sequence set forth in SEQ ID NO: 1.

Applicants respectfully point out that the Examiner's reasons for restriction only reference Groups I-VI whereas the Examiner alleges that there are VIII Groups of inventions. Furthermore, applicants respectfully point out that the Examiner's reasons are unrelated to the actual claims. Groups I-VI as identified by the Examiner are directed to nucleic acids; however, the Examiner refers to the inventions of these groups as "methods" and "product and process of use".

Applicants note that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." [Emphasis added]. Applicants request that the restriction requirement be withdrawn in view of the fact that the claims of Groups I-VIII are not independent.

Under M.P.E.P. §802.1, "independent" means "there is no disclosed relationship between the subjects disclosed, that is, they are unconnected in design, operation, and effect...". The claims of Group I-VII are related in that they are drawn to nucleic acids encoding chimeric G proteins and uses of chimeric G proteins.

Applicants therefore respectfully assert that two or more independent and distinct inventions have not been claimed in the subject application because the groups are not independent under

M.P.E.P. §802.01. Therefore, restriction is improper under 35 U.S.C. §121.

Additionally, applicants point out that under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely (1) the invention must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

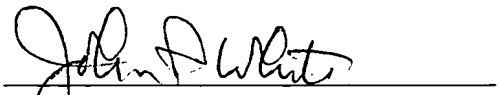
Applicants maintain that there would not be a serious burden on the Examiner if restriction were not required. A search of prior art with regard to any of Groups I-VIII would necessarily identify art for the other Groups. Since there is no serious burden on the Examiner to examine Groups I-VIII in the subject application, the Examiner must examine the entire application on the merits.

Accordingly, in view of the preceding remarks, applicants respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

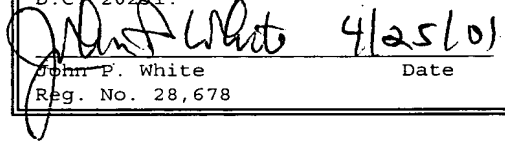
No fee is deemed necessary in connection with the filing of this Communication. However, if a fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Attorney for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.



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John P. White
Reg. No. 28,678

Date